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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/627,270	04/04/1996	HIDEAKI TOJO	SKO-104-A-1	8796

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EXAMINER

ROSENBAUM, IRENE CUDA

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 09/12/2003

45

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/627,270

Applicant(s)

TOJO ET AL

Examiner

Irene Cuda-Rosenbaum

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/20/02, 4/2/03 and 4/4/04.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16, 19, 20, 27, 30-33 and 36-46 is/are pending in the application.
- 4a) Of the above claim(s) 14-16, 19 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20, 27, 30-33 and 37-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Receipt is acknowledged of applicant's request for an CPA and the amendment filed therewith, on 12/20/02, and of applicant's supplemental preliminary amendments , filed on 4/2/03 and 4/4/03.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14-16,19-20,27,30-33 and 36-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims have been amended to recite applying a peelable paint. This limitation is not literally supported by the originally-filed disclosure, which only discloses a strippable paint. TH e documents submitted with paper no. 43 do not satisfactorily establish that LAPGUARD L was known to be a peelable paint at the time the application was filed. The document subtitled "Paint Film Performance Report" bears a date of 18 August 1992 but does not disclose LAPGUARD L as peelable. The document titled only "LAPGUARD L" , which discloses LAPGUARD L as peelable, bears no date .

New claim 46, submitted with amendment G, filed March 27th, 2003, recites that the peelable paint has a sufficient thickness to protect the painted surface against scratches during assembly. This new claim is not supported anywhere in the originally-filed specification. While applicant has also amended the specification to provide antecedent basis for this new claim, that amendment is new matter.

Should applicant traverse any or all of the above rejections, citation (including page and line number)is required of those portions of the originally-filed disclosure which applicant believes provides support for the limitations in question.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 43 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "sufficiently long period of time" in this claim is a relative term which renders the claim indefinite. the term "sufficiently long period of time" is not defined by the claim the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. While the specification describes specific temperature and humidity parameters of the treatment step, it does not describe what the purpose of the step is other than to "stabilize" the coating. Since the specification provides no explanation of the place of the stabilization step in the overall process (other then merely allowing the coated surface to sit at what reads on ambient conditions) or the

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nature of the stabilizing activity, , it is the examiners position that one of ordinary skill in the art would not be reasonably apprised of the metes and bounds of "a sufficiently long period of time".

Specification

The amendment filed March 27th, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- (a) that LAPGUARD L is a peelable paint; and
- (b) that the protective film formed in said peelable paint coating step has a sufficient thickness to protect the paint finished automobile body from scratches during the assembling.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20,27,30-33,37-40 and 43-46 rejected under 35 U.S.C. 103(a) as being unpatentable over Woodhall et al (5,186,978) in view of Omori et al (4,727,232) and vice versa.

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With respect to claim 20, Woodhall teaches a method in which a water based peelable paint is applied to the surface of a vehicle ((i.e. automobile) and then dried (abstract; column 1 line 1 –column 2, line 3; column 2 lines 23-25; and column 4, lines 44-56). The peelable paint protects the product from damage during mechanical processing operations that may be performed during the assembly line production of the vehicle (column 1, line 1, - column 2, line 3 and column 2, lines 23-52). The mechanical assembly line operations would include the assembling of the engine and functional parts into the automobile body.

The examiner notes that Woodhall teaches that the peelable paint may be applied over spray applied paint.

Woodhall fails to teach that the automobile parts are formed by press forming panel parts from sheet metal and welding the panel parts together to form an automobile body.

Oromi teaches that surfaces of an automobile vehicle body are conventionally formed by press forming welding and painting (column 1, lines 12-59).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method as taught by Woodhall by forming the automobile parts by press forming and then welding them, since to do so is the conventional method of assembling automobiles , as taught by Oromi.

In the alternative, and also based on the teachings of the two references, it would have been obvious to one of ordinary skill in the art to modify the method of Oromi , to coat the automobile with a peelable paint after it has been painted, in order to protect

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the vehicle from damage during subsequent mechanical operations performed on the product, as taught by Woodhall.

The examiner notes that Woodhall teaches drying the peelable paint, either at ambient temperature or by baking. The examiner has carefully considered those portions of the specification disclosing partial and final drying and has concluded that partial drying and final drying as claimed by applicant reads on simply drying the paint. Inherently, the paint must be partially dried before it is fully dried, no matter what the drying scheme. Whether a single drying means or multiple drying means are used would be an obvious matter of design choice which would depend on the desired particulars of the final product and would be determined through routine experimentation.

With respect to claims 33 and 37, Woodhall teaches that the peelable paint may be dried at above ambient temperatures giving an example of 130 degrees F (55 degrees C) (see column 4, line 55). This would be an elevated temperature as claimed.

The use of IR radiation in conjunction with hot air is a well-known expedient to drying coatings and official notice is taken of such. Consequently, it is considered that it would have been obvious to one of ordinary skill in the art to modify the combination as explained above so as to dry the peelable coating by IR radiation in conjunction with hot air(claim 30)

Regarding claim 31-32 and 40 neither Woodhall nor Omori explicitly teach that the peelable paint is stabilized prior to drying and that this is done at ambient conditions. It is the examiners position that ambient conditions would have been the most readily

apparent and convenient condition to one of ordinary skill in the art, requiring no modification of the surrounding environment . Consequently, it would have been obvious to one of ordinary skill in the art to apply peelable paint of Woodhall under ambient conditions because ambient conditions would have been the most cost and time effective conditions available to do so. Any point prior to drying at which the peelable paint-coated product sits at ambient (for any period of time) reads on the claimed stabilizing treatment.

Regarding the limitation in claims 41-42 of the paint being dried from inside the coating in the preliminary drying step and drying the paint from outside the coating in the non-preliminary drying step, this limitation is read to mean that the peelable paint dries from the interface with the finished product outward. Applicant has not disclosed just how drying from the inside out occurs, rather they describe irradiating with IR radiation. It is the examiners position that IR radiation is a well-known expedient to the drying process of coating. Consequently, it would have been obvious to one of ordinary skill in the art to have modified the method of Woodhall in view of Omori, and vice versa, so as to dry the peelable coating by IR radiation and thus based on applicant's disclosure, drying from the inside out naturally flows from the modification.

With respect to claim 46, it is the examiner position that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the thickness of a peelable paint determines the degree and uniformity of protection afforded the painted surface. Consequently, given that Woodhall is concerned with protecting underlying surfaces from damage, it would have been obvious to one of

ordinary skill in the art to coat the peelable paint in an appropriate thickness to achieve adequate protection.

Claims 27,30,31-33,37 and 40-44, rejected under 35 U.S.C. 103(a) as being unpatentable over Woodhall in view of Omori , or vice versa, as set forth above, and further in view of Nelson et al (4,907,533).

Neither Woodhall nor Omori teach that the pelable paint is first partially dried from inside out and then finally dried as claimed. Nelson teaches a method of drying a coating applied to an automobile surface in which the coating is first partially dried and then finally dried. (see column 9-100. Nelson teaches that this method yields a higher quality coating in a shorter amount of time and is particularly desirable and well suited for water based coating compositions.

It would have been obvious to one of ordinary skill in the a art to modify the method of Woodhall in view of Omori , or vice versa, so as to first partially dry and then finally dry the peelable paint, since to do so would result in a higher quality coating in a shorter amount of time , as taught by Nelson.

Further, Nelson teaches that the step of partially drying uses IR radiation and the step of finally drying uses hot air drying(column 9-10).

Claims 31,32,40 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woodhall in view of Omori , or vice versa, in view o fNelson, as applied to claim 27 above, and further in view of Bradshaw (4,367,787).

Woodhall in view of Omori , or vice versa, in view of Nelson teach all o fthe limitations , as described above, but lack a teaching that the paint is stabilized in a

controlled environment , specifically in an ambient temperature of 15-30 degrees C and an ambient humidity of 50-80%.

Bradshaw teaches that , in automotive coating applications, water based coatings are applied in paint spray booths that have tightly controlled conditions of temperature and humidity (see column 1, lines 1-25). Specifically, Bradshaw teaches as conventional a temperature of 24 degrees C and a humidity of 50% (see column 1, lines 10-20) This temperature falls within the range of 15-30 degrees C as claimed by applicant.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Woodall in view of Omori, or vice versa, further in view of Nelson, to use the stabilizing environment as claimed, since to do so is old and well known in the automotive painting art, as taught by Bradshaw, for the purpose of obtaining a better application of the paint.

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woodhall in view of Omori , or vice versa, and further in view of Grogan.

Woodhall in view of Omori teach the method essentially as claimed, as explained above, but lack a teaching of inspecting and shipping with the protective film in place.

Grogan teaches utilizing a peelable coating to protect the finish on an automobile during handling, storage, and transit to protect against weathering and accidental damage (see column 1, lines 22-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method as taught by Woodhall in view of Omori , or

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vice versa, by leaving the protective coating on during inspecting and shipping , since ot do so is old and well known in ht e art , for the purpose of protecting against damage, as taught by Grogan.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20,27,30-33, and 37-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8,63,65,9,36-38,12 and 66 of copending Application No. 08/398881. Although the conflicting claims are not identical, they are not patentably distinct from each other because there are only minor wording differences in the claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

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Applicant's arguments filed 4/2, 4/4, and 12/2 have been fully considered but they are not persuasive. It is believed that applicant's arguments are answered by the above rejections.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Cuda-Rosenbaum whose telephone number is 703-308-1792. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are 7033087058 for regular communications and 7033087058 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1148.

ICR
September 9, 2003

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See R
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